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09/978,551	10/18/2001	Hirota Noro	740670-269	5064

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EXAMINER

TANG, KAREN C

ART UNIT	PAPER NUMBER
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2151

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/978,551

Applicant(s)

NORO, HIROTAKE

Examiner

Karen C. Tang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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- This action is responsive to the amendment and remarks file on 10/4/06.
- Claims 7-9 are amended are for further examination.
- Withdraw 101 rejections.

DETAILED ACTION

Response to Arguments

Applicant argued that there is no suggestion to combine the Fukuda and AAPA.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear that in each claims it indicate that "means contained in the control apparatus adapted to operate to initialize., when the information of claiming the copyright is judged not to be included.". Therefore, it is being interpreted as "means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included." for examining purpose.

Claim 7-9 cites the limitation "the completion of the recording of one piece of music" in Page 3, Lines 1-2, and 4-5, Page 4, Lines 3-4 and 9-10 and page 5, lines 7-8 and lines 10-11.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (US 6,594,740) in view of Applicant Admitted Prior Art (AAPA - Background Information).

1. Referring to Claim 7, Fukuda discloses audio system having a recording/reproducing apparatus for recording on a record disk music data reproduced from a reproduction disk and a

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control apparatus for controlling the recording/reproducing apparatus, the control apparatus being adapted to communicate with an external information management server via a predetermined interface, the audio system comprising:

means contained in the recording/reproducing apparatus for transferring identification information for identifying a target reproduction disk to the control apparatus (Col 2, Lines 45-60, Col 7, Lines 20-35, Col 17, Col 19, Lines 15-67);

means contained in the control apparatus for communicating with the external information management server to acquire disk information of the target reproduction disk from the external information management server on the basis of the identification information (refer to Col 10, Lines 25-35, Col 20, Lines 15-67);

and means contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20 and Col 19, and 20).

means contained in the control apparatus, the means operating to extract title information from the acquired disk information of the target reproduction disk (refer to Col 18, Lines 1-10);

and means contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20, Col 19, Col 20).

Fukuda does not expressly disclose transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music.

AAPA discloses transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music (pg 2, Lines 15-25, Pg 3, and pg 4, Lines 1-10, the claim language does expressly indicate

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the correspondence between the title of the music and the piece of the music that are being recorded/reproduced, therefore, for example, once the system senses that a music piece A is completely recorded/reproduced (completion of the recording of one piece of music), then the system starts transferring the title of music piece B (transferring the extracted title information), once that is being completed, the system starts to record/reproduce music piece B.).

Fukuda did not expressly indicate means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright.

AAPA disclosed means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright (refer to Page 2, Lines 25-30 and Page 3, Lines 1-15 and Page 4, Lines 12-16).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the AAPA and Fukuda. Both Fukuda and AAPA inventions are about recording music pieces with their relevant information, and Fukuda discloses methods of reproducing/recording music including the title and related information (Col 21, Lines 1-10) and the arts are analogous.

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Fukuda did not expressly disclosed means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included.

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AAPA disclosed means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included (refer to Page 4, Lines 13-16).

At the time of the invention, it would have been obvious to combine Fukuda and AAPA since the arts are analogous.

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Fukuda did not expressly indicate the means for judging whether or not a track change has occurred to decide the completion of the recording of one piece of music.

AAPA disclosed means for judging whether or not a track change has occurred to decide the completion of the recording of one piece of music (decided the recording of music data is complete, refer to Page 2, Lines 24-25)

At the time of the invention, it would have been obvious to combine Fukuda and AAPA since the arts are analogous.

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

2. Referring to Claim 8, Fukuda discloses an audio system having a recording/reproducing apparatus for recording on a record disk music data reproduced from a reproduction disk and a control apparatus for controlling the recording/reproducing apparatus, the control apparatus

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being adapted to communicate with an external information management server via a predetermined interface, the audio system comprising:

means contained in the recording/reproducing apparatus for transferring identification information for identifying a target reproduction disk to the control apparatus (Col 2, Lines 45-60, Col 7, Lines 20-35, Col 17, Col 19, Lines 15-67 and Col 10, lines 20-59 and Col 20, Lines 30-55);

means contained in the control apparatus for communicating with the external information management server to acquire disk information of the target reproduction disk from the external information management server on the basis of the identification information (Col 10, Lines 25-35, and Col 20, Lines 15-67);

means contained in the control apparatus, the means operating to extract title information from the acquired disk information of the target reproduction disk (refer to Col 18, Lines 1-10),

and means contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20, Col 19, Col 20).

Fukuda does not expressly disclose in accordance with information in the title area in the memory, for editing the extracted title information to instruct the recording/reproducing apparatus to record the music data after completing the editing, and to transfer the edited title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of the music data in the recording/reproducing apparatus;

AAPA discloses in accordance with information in the title area in the memory, for editing the extracted title information to instruct the and to transfer the edited title information from the memory in response to the completion of the recording of the music data in the

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recording/reproducing apparatus (pg 2, Lines 15-25, Pg 3, and pg 4, Lines 1-10, it is being interpreted that extracted title is being transferred in response to the one piece of music is completely recorded.);

Fukuda did not expressly indicate means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright.

AAPA disclosed means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright (refer to Page 2, Lines 25-30 and Page 3, Lines 1-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the AAPA and Fukuda. Both Fukuda and AAPA inventions are about recording music pieces with their relevant information, and Fukuda discloses methods of reproducing/recording music including the title and related information (Col 21, Lines 1-10).

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Fukuda did not expressly disclosed means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included.

AAPA disclosed means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included (refer to Page 4, Lines 13-16).

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At the time of the invention, it would have been obvious to combine Fukuda and AAPA since the arts are analogous.

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Fukuda did not expressly indicate the means for judging whether or not a track change has occurred to decide the completion of the recording of one piece of music.

AAPA disclosed means for judging whether or not a track change has occurred to decide the completion of the recording of one piece of music (decided the recording of music data is complete, refer to Page 2, Lines 24-25)

At the time of the invention, it would have been obvious to combine Fukuda and AAPA since the arts are analogous.

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

3. Referring to Claim 9, Fukuda discloses an audio system having a recording/reproducing apparatus for recording on a record disk music data reproduced from a reproduction disk and a control apparatus for controlling the recording/reproducing apparatus, the control apparatus being adapted to communicate with an external information management server via a predetermined interface, the audio system comprising:

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means contained in the recording/reproducing apparatus for transferring both identification information for identifying a target reproduction disk and text data acquired from the target reproduction disk to the control apparatus (Col 2, Lines 45-60, Col 7, Lines 20-35, Col 17, Col 19, Lines 15-67 and Col 10, lines 20-59 and Col 20, Lines 30-55);

means contained in the control apparatus for communicating with the external information management server to acquire disk information of the targets reproduction disk from the external information management server on the basis of the identification information (refer to Col 17, Lines 1-20, Col 19, Col 20);

means contained in the control apparatus for extracting title information from the acquired disk information of the target reproduction disk and for transferring the extracted title information to the recording/reproducing apparatus (refer to Col 17, Lines 1-20 and Col 19, and 20); and means contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20 and Col 19, and 20).

Fukuda does not expressly disclose contained in the control apparatus for editing the text data and does not expressly discloses transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music.

AAPA discloses means contained in the control apparatus for editing the text data and transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music (pg 2, Lines 15-25, Pg 3, and pg 4, Lines 1-10, it is being interprets that extracted title is being transferred in response to the one piece of music is completely recorded.);

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Fukuda did not expressly indicate means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright.

AAPA disclosed means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright (refer to Page 2, Lines 25-30 and Page 3, Lines 1-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the AAPA and Fukuda. Both Fukuda and AAPA inventions are about recording music pieces with their relevant information, and Fukuda discloses methods of reproducing/recording music including the title and related information (Col 21, Lines 1-10).

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Fukuda did not expressly disclosed means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included.

AAPA disclosed means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of the claiming the copyright is judged to be included (refer to Page 4, Lines 13-16).

At the time of the invention, it would have been obvious to combine Fukuda and AAPA since the arts are analogous.

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The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Fukuda did not expressly indicate the means for judging whether or not a track change has occurred to decide the completion of the recording of one piece of music.

AAPA disclosed means for judging whether or not a track change has occurred to decide the completion of the recording of one piece of music (decided the recording of music data is complete, refer to Page 2, Lines 24-25)

At the time of the invention, it would have been obvious to combine Fukuda and AAPA since the arts are analogous.

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Conclusion

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ZARNI MAUNG
SUPERVISORY PATENT EXAMINER